

ESTTA Tracking number: **ESTTA564204**

Filing date: **10/10/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Primal Wear, Inc.
Granted to Date of previous extension	11/27/2013
Address	7700 Cherry Creek South Drive, Suite 106 Denver, CO 80231 UNITED STATES
Attorney information	Tamara Pester Tamara S. Pester, LLC 100 Fillmore Street #500 Denver, CO 80206 UNITED STATES info@tamarapester.com Phone:3033334696

Applicant Information

Application No	85689425	Publication date	07/30/2013
Opposition Filing Date	10/10/2013	Opposition Period Ends	11/27/2013
Applicant	LB Brands, LLC P.O. Box 239 Port Clyde, ME 04855 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: clothing, namely, tops, bottoms and headwear

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3494801	Application Date	07/13/2007
Registration Date	09/02/2008	Foreign Priority Date	NONE
Word Mark	PRIMAL		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1992/08/01 First Use In Commerce: 1992/08/01 Clothing, headwear and sportswear, namely, shorts, tights, shirts, jerseys, jackets, headbands, and hats

U.S. Registration No.	3350960	Application Date	01/08/2007
Registration Date	12/11/2007	Foreign Priority Date	NONE
Word Mark	PRIMAL WEAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1992/08/01 First Use In Commerce: 1992/08/01 Clothing, headwear, and sportswear, namely, shorts, tights, shirts, jerseys, headbands, and hats		

U.S. Registration No.	4194778	Application Date	03/23/2012
Registration Date	08/21/2012	Foreign Priority Date	NONE
Word Mark	PRIMAL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1992/09/20 First Use In Commerce: 1992/09/20 Custom design of athletic apparel based on personal selections made by the customer; Design and development of custom athletic apparel; Graphic illustration services for others		

U.S. Registration No.	3626226	Application Date	09/15/2008
Registration Date	05/26/2009	Foreign Priority Date	NONE
Word Mark	P PRIMAL		
Design Mark			
Description of Mark	The mark consists of the word "PRIMAL" with a flame underlining it. Above the word "PRIMAL" is a stylized letter "P", which is outlined and shaded.		
Goods/Services	Class 025. First use: First Use: 2008/06/01 First Use In Commerce: 2008/06/01 Clothing, headwear and sportswear, namely, shorts, tights, shirts, jerseys, jackets, headbands, and hats		

U.S. Registration No.	3626224	Application Date	09/15/2008
Registration Date	05/26/2009	Foreign Priority Date	NONE
Word Mark	P3 PRIMAL3		
Design Mark			
Description of	The mark consists of the word "PRIMAL" in with an outlined numeral "3"		

Mark	attached to the top of the "P". A flame underlines the word "PRIMAL". A design element above the word "PRIMAL" consists of an oval, which is shaded, containing a capital "P" and a numeral "3" attached to it.
Goods/Services	Class 025. First use: First Use: 2008/06/01 First Use In Commerce: 2008/06/01 Clothing, headwear and sportswear, namely, shorts, tights, shirts, jerseys, jackets, headbands, and hats

Attachments	STIRS YOUR PRIMAL SENSES opp.pdf(108135 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Tamara Pester/
Name	Tamara Pester
Date	10/10/2013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of:

Trademark Application Serial No. **85/689,425**

For the mark: IT STIRS YOUR PRIMAL SENSES

Primal Wear, Inc.,
Opposer

v.

LB Brands, LLC
Applicant

Opposition No.: _____

Application No.: 85/689,425

Trademark: IT STIRS YOUR PRIMAL SENSES

NOTICE OF OPPOSITION

Opposer, Primal Wear Inc., a Colorado corporation believes it is or will be damaged by registration on the Principal Register of the mark IT STIRS YOUR PRIMAL SENSES shown in Application No.: 85/689,425, and hereby opposes the same. The grounds for opposition are as follows:

1. Petitioner Primal Wear, Inc. (“Primal Wear”) is a corporation duly organized and existing under the laws of the State of Colorado, with a principal place of business at 7700 Cherry Creek South Drive, Suite 106, Denver, CO 80231.
2. Since at least as early as 1992, Primal Wear has been engaged in the development, advertising, distribution and sale of various products and services, focusing primarily on clothing and the custom design of clothing for others, as well as the organization and sponsorship of athletic events.
3. Primal Wear owns several valid and subsisting U.S. trademark registrations and applications (the “PRIMAL Marks”) including Reg. Ser. No. 3494801 for the mark PRIMAL in connection with “clothing, headwear and sportswear, namely, tights, shirts, jerseys, jackets, headbands and hats” in International Class 25, which was registered on the Principal Register on September 2, 2008. A Sections 8 and 15 combined declaration for Reg. Ser. No. 3494801

was accepted and acknowledged on September 19, 2013.

4. Primal Wear owns U.S. trademark Reg. Ser. No. 3350960 for PRIMAL WEAR & Design in connection with “clothing, headwear, and sportswear, namely, shorts, tights, shirts, jerseys, headbands, and hats” in International Class 25, which was registered on the Principal Register on December 11, 2007. A Sections 8 and 15 combined declaration for this registration was accepted and acknowledged on March 4, 2013.
5. Primal Wear owns U.S. trademark Reg. Ser. No. 4194778 for PRIMAL in connection with “Custom design of athletic apparel based on personal selections made by the customer; Design and development of custom athletic apparel; Graphic illustration services for others” in International Class 42, which was registered on the Principal Register on August 21, 2012.
6. Primal Wear owns U.S. trademark Reg. Ser. No. 4198616 for PRIMAL WEAR in connection with “Class 25: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Clothing, namely, arm warmers; Cycling shorts; Cyclists' jerseys; Leg warmers; Skullies; Socks; Triathlon clothing, namely, triathlon tights, triathlon shorts, triathlon singlets, triathlon shirts, triathlon suits” in International Class 25, which was registered on the Principal Register on August 28, 2012.
7. Primal Wear owns U.S. trademark Reg. Ser. No. Reg. 3626226 for P PRIMAL & Design in connection with “Clothing, headwear and sportswear, namely, shorts, tights, shirts, jerseys, jackets, headbands, and hats” in International Class 25, which was registered on the Principal Register on May 26, 2009.
8. Primal Wear owns U.S. trademark Reg. Ser. No. Reg. 3626224 for P3 PRIMAL & Design in connection with “Clothing, headwear and sportswear, namely, shorts, tights, shirts, jerseys, jackets, headbands, and hats” in International Class 25, which was registered on the Principal Register on May 26, 2009.
9. Primal Wear uses the mark PRIMAL or variations thereof in other countries.
10. Primal Wear owns valid trademark registrations or applications in Mexico, the European

Union, and Australia.

11. Since as early as August 1992, Primal Wear has continuously used the word PRIMAL, as well as various iterations of the mark and various design marks, including the PRIMAL Marks noted above, in interstate commerce on or in connection with apparel.
12. The PRIMAL Marks have become a valuable asset of the business, identifying its clothing and various other products and services related or complementary thereto, and distinguishing Primal Wear's products and services from the products and services of others.
13. When used in connection with Primal Wear's goods and services, the PRIMAL marks are inherently distinctive.
14. The PRIMAL Marks have been extensively advertised in the United States and throughout the world, and have appeared on or in relation to products, hang tags, and other promotional materials for products sold, offered and advertised, and/or has been used in connection with clothing, headwear and sportswear, namely, tights, shirts, jerseys, jackets, headbands and hats and various other products and services related or complementary thereto advertised, offered, conducted and/or promoted in the United States and throughout the world.
15. Primal Wear has expended considerable time, money and effort in advertising and promoting the PRIMAL marks, the clothing and other goods and services sold under the marks, and in developing substantial and exclusive goodwill and reputation in connection with the marks and the goods and services associated therewith.
16. Worldwide annual sales of Primal Wear's PRIMAL branded clothing exceed 500,000 units, with over 450,000 units sold annually in the United States. Since the inception of the company, Primal Wear has sold over \$53,000,000.00 of products, with over 2 million units sold. Out of the 44,000,000 results posted by Google for a "Primal" search, Primal Wear ranks as the #1 listing.
17. As a result of the enormous success and sales of PRIMAL clothing and of the extensive advertising and promotion of the PRIMAL marks and products in the United States and

throughout the world, the mark PRIMAL has become a famous mark, and is recognized in the United States and elsewhere as such.

18. Applicant filed Application Serial No. 85/689,425 on August 6, 2012, for the trademark IT STIRS YOUR PRIMAL SENSES based on an intent to use the mark in commerce on the International Class 25 goods set forth in said application, namely “[c]lothing, namely tops, bottoms and headwear.”
19. Upon information and belief, Primal Wear’s use of the mark PRIMAL predates Applicant’s date of its application for use of IT STIRS YOUR PRIMAL SENSES by more than twenty-one years.
20. According to the U.S. Patent and Trademark Office records, Applicant is a limited liability company whose address is given as P.O. Box 239, Port Clyde, Maine 04855.
21. Primal Wear has used the Primal Marks extensively on directly competitive goods, such use being prior to Applicant’s proposed use of the IT STIRS YOUR PRIMAL SENSES trademark on apparel and/or Applicant’s filing date of its Application.
22. Applicant’s mark IT STIRS YOUR PRIMAL SENSES, by using the root word PRIMAL, so resembles Primal Wear’s previously used PRIMAL marks as to be likely, when applied to the goods in International Class 25, to cause confusion, mistake or deception among purchasers, users, and the public as to the source of Applicant’s goods, thereby damaging Primal Wear in violation of Section 2(d) of the Trademark Act, 15 U.S.C. §1052 (d), and interfering with Primal Wear’s prior use of its trademark and causing irreparable harm to Primal Wear.
23. The goods on which Applicant seeks to register the mark IT STIRS YOUR PRIMAL SENSES are the same as, used for the same or similar purposes, and/or are within the natural zone of expansion, of Primal Wear’s goods and services.
24. The Primal registrations encompass in full the goods subject of Applicant’s application: “[c]lothing, namely tops, bottoms and headwear.”

25. Applicant's goods appeal to the same class of consumers and/or are or will be advertised and promoted to and directed at the same trade channels, and are or will be used in the same environment as Primal Wear's products and related goods and services.
26. Simultaneous use of Applicant's mark and Primal Wear's marks on its goods and related services as set forth above is likely to cause confusion, mistake or deception among purchasers, users, and the public, thereby damaging Primal Wear.
27. Use by Applicant of the alleged mark IT STIRS YOUR PRIMAL SENSES on the subject goods is likely to lead to the mistaken belief that Applicant's products are sponsored by, affiliated with, approved by, or otherwise emanate from Primal Wear, thereby damaging Primal Wear.
28. Applicant should have known of Primal Wear's prior adoption and use of its PRIMAL mark, and therefore could not have formed the requisite good faith belief that no other person, firm, corporation or association has the right to use said mark in commerce, and consequently knew that such use is and would be in derogation and violation of Primal Wear's rights.
29. Primal Wear will be seriously damaged by the registration of IT STIRS YOUR PRIMAL SENSES, Application Serial No. 85/689,425, as applied to the goods in International Class 25, and therefore respectfully requests that this opposition be sustained and that Application Serial No. 85/689,425 be refused.

The statutory fee for the Notice of Opposition was paid at the time of the filing.

Respectfully Submitted,

Primal Wear, Inc.
By: /Tamara Pester/
Tamara S. Pester

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION is being served on October 10, 2013 on counsel for Applicant by deposit of same in the United State

Mail, first class postage prepaid, in an envelope addressed to (and with courtesy copy to James Keenan jkeenan@bernsteinshur.com):

LB Brands, LLC
P.O. Box 239
Port Clyde, Maine 04855

JAMES F. KEENAN, JR.
BERNSTEIN, SHUR, SAWYER & NELSON
100 MIDDLE ST STE 9
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